

Applicant: Mario Meggiolan
Application No.: 10/815,585

REMARKS

After the foregoing Amendment, claims 1-4, 6 - 7; 9 - 10 and 43 are currently pending in this application. Claims 1, 9, 10 and 43 have been amended. Claims 11 - 42 have been withdrawn from consideration. Applicant submits that no new matter has been introduced into the application by these amendments.

Claim Rejections - 35 USC § 103

Claims 1 – 7, 9 – 11, and 43 were rejected in the Action under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,347,839 to Lew in view of U.S. Patent No. 6,283,557 to Okajima.

Applicant respectfully traverses the rejection. Claim 1 recites a bicycle wheel rim, comprising an inner peripheral wall, an outer peripheral wall, two lateral walls joining said peripheral walls and two circumferential wings, for anchoring a tire, which extend outwards from the two sides of the outer peripheral wall, wherein said rim is made of a single part of structural fiber based material incorporating the two circumferential wings and wherein the rim has a layered structure of a plurality of nested layers of fiber based fabric material, including at least first layers selected from the nested layers extending so as to contribute to define the inner wall, the lateral walls and the two wings of the rim, and second differently selected layers

from the plurality of layers arranged so as to define the inner, lateral and outer walls of the rim.

Claim 9 recites a bicycle wheel rim, comprising an inner peripheral wall, an outer peripheral wall, two lateral walls joining said peripheral walls and two circumferential wings, for anchoring a tire, which extend outwards from the two sides of the outer peripheral wall, wherein said rim is made of a single part of structural fiber based material incorporating the two circumferential wings, and wherein the rim has a layered structure of a plurality of nested layers of fiber based fabric material, including at least first layers selected from the nested layers extending so as to define the inner wall, the lateral walls and the two wings of the rim and second differently selected layers from the plurality of layers arranged so as to define the inner, lateral and outer walls of the rim.

Claim 10 recites a bicycle wheel rim, comprising an inner peripheral wall, an outer peripheral wall, two lateral walls joining said peripheral walls and two circumferential wings, for anchoring a tire, which extend outwards from the two sides of the outer peripheral wall, wherein said rim is made of a single part of structural fiber based material incorporating the two circumferential wings, wherein the rim has a layered structure of a plurality of nested layers of fiber based fabric material, including at least first layers selected from the nested layers extending so as to define the inner wall, the lateral walls and the two wings of the

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rim and second differently selected layers from the plurality of layers arranged so as to define the inner, lateral and outer walls of the rim, and wherein the layered structure further includes third differently selected layers from the plurality of layers arranged to define the outer wall and the two wings of the rim.

Claim 43 recites a bicycle wheel rim comprising a plurality of nested layers of fiber based fabric incorporated in a thermosetting plastic material matrix that are arranged as an inner wall; an outer wall; two circumferential wings; and two lateral walls that connect the inner wall, outer wall and two circumferential wings, the outer wall is comprised of a first set of selected layers from the plurality of nested layers that also comprise part of the inner and lateral walls and the two circumferential wings are comprised of a second set of differently selected layers from the plurality of nested layers that also comprise part of the inner and lateral walls.

Lew teaches a bicycle tire rim made of sheets of fiber glass. The sheets are stacked and then molded to shape a bicycle rim. The rim of Lew has only an inner wall which is comprised of all of the stacked sheets. The two lateral walls of the rim of Lew are also made up of all of the stacked sheets. This is in contrast to the present invention. As is claimed, the rim of the present invention comprises an inner peripheral wall, an outer peripheral wall, two lateral walls joining said peripheral walls and two circumferential wings, for anchoring a tire, which extend

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outwards from the two sides of the outer peripheral wall, wherein said rim is made of a single part of structural fiber based material incorporating the two circumferential wings and wherein the rim has a layered structure of a plurality of nested layers of fiber based fabric material, including at least first layers selected from the nested layers extending so as to contribute to define the inner wall, the lateral walls and the two wings of the rim, and second differently selected layers from the plurality of layers arranged so as to define the inner, lateral and outer walls of the rim. Not all of the sheets or layers of the present invention form the wings, inner, outer or the two lateral walls. The rim of Lew however, utilizes the same number of sheets throughout.

The Action states that it would be obvious to modify the Lew reference with Okajima, to include the use of an outer peripheral wall. There are, however, problems with this statement. First, Lew is silent with respect to an outer peripheral wall. Second, it is well settled in the law that the fact that the prior art could be modified to produce the claimed invention does not make the claimed invention obvious unless there is something in the prior art to suggest the desirability of making such a modification. *In re Laskowski* 10 USPQ2d 1397, 1398 (Fed.Cir. 1980).

It is also settled that when there is no explanation of the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the

invention to the claimed combination as a whole, it is inferred that hindsight was used to conclude that the invention was obvious. The "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006).

In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection advanced. The Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *Ex parte Haymond*, 41 USPQ2d 1217 (BdPatApp&Int 1996). That is, there must be some logical reason apparent from positive, concrete evidence of record which justifies a suggestion to modify a prior art structure. See *In re Regel*, 188 USPQ 136, 139 (CCPA 1975). No such evidence to combine the references was provided in the Action, which merely combined the two references after reviewing the claimed subject matter. There is also nothing to suggest that the use of an outer peripheral wall can be implemented in the rim of Lew since there is no way that the configuration of the mold disclosed in Lew is capable of molding a rim with an outer peripheral wall. The Examiner raises this combination without any support in the art. In fact, Lew teaches away from the proposed combination in the Background of the Invention. There is no justification for the Examiner's position that one of

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ordinary skill in the art would combine Lew with Okajima to arrive at the claimed invention.

The MPEP (2141) states that when applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

MPEP 2141.02 (VI) states that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Under well-settled law, "when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Ecocolchem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000) (quoting *In re Beattie*, 974 F.2d 1309, 13 1 1 - 12 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730

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F.2d 1452, 1462 (Fed. Cir. 1984))). Furthermore, MPEP 2141.02 (I) states that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

Furthermore, Okajima fails to remedy the deficiencies of Lew since the proposed combination does not show that the rim has a layered structure of fiber based fabric material, including at least first layers selected from the nested layers extending so as to define the inner wall, the lateral walls and the two wings of the rim and second differently selected layers from the plurality of layers arranged so as to define the inner, lateral and outer walls of the rim as is claimed in claim 9. There is also no teaching in the combination of Okajima and Lew that the rim has a layered structure of a plurality of nested layers of fiber based fabric material, including at least first layers selected from the nested layers extending so as to define the inner wall, the lateral walls and the two wings of the rim and second differently selected layers from the plurality of layers arranged so as to define the inner, lateral and outer walls of the rim, and wherein the layered structure further includes third differently selected layers from the plurality of layers arranged to define the outer wall and the two wings of the rim as is claimed in claim 10.

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Finally, the combination of Okajima and Lew does not teach that the outer wall is comprised of a first set of selected layers from the plurality of nested layers that also comprise part of the inner and lateral walls and the two circumferential wings are comprised of a second set of differently selected layers from the plurality of nested layers that also comprise part of the inner and lateral walls as is claimed in claim 43.

Conclusion

It is believed that the pending claims are allowable and a Notice of Allowance is respectfully requested. Should the Examiner believe that an interview would advance the prosecution of the application, the Examiner is invited to contact the undersigned at the Examiner's convenience.

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In view of the foregoing remarks, Applicant respectfully submits that the present application, including claims 1-4, 6 - 7, 9 - 10 and 43, is in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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